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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,688	10/05/2000	Kenneth O. Lipscomb	26006.0001U3	8953

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Gregory S. Smith
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EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,688

Applicant(s)

LIPSCOMB ET AL.

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 30-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 46-49 is/are allowed.
- 6) ☒ Claim(s) 30-34,37-41,44 and 45 is/are rejected.
- 7) ☒ Claim(s) 35,36,42 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>enclosed</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

1. This communication is in response to amendment/response filed 08/03/04 and 10/04/04, claim 1 was amended and 3-29 canceled on 08/03/04 and claims 30-49 were added via the second 10/04/04 amendment/response.

2. Telephonic interview initiated by examiner was conducted (12/02-03/04), details noted on PTO-413 attached. Examiner appreciated applicant's cooperation.

3. Claims 1-2 and 46-49 contain allowable subject matter. In this case, specifically, the following subject matter as a whole has been identified as the subject matter, which makes these claims allowable.

Specifically, the transfer of a reference (identifier) to new license media asset to the portal for access by a plurality of media players of the user (set forth on claim 1), and accessing media assets referenced in the virtual media asset library at the portal to media asset (located) across a plurality of media player devices (set forth on claim 46), is not taught by the prior art of record.

4. Claims 35 (and 36 by virtue of dependency) and 42-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In this case, these contain substantially the same subject matter noted above.

Claim Rejection under 35 U.S.C. 103

5. Claim 30-34, 37-41 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milsted et. al. (US 6,345,256) (referred to as Milsted hereafter) in view of Inala et. al. (US 6,199,077) (referred to as Inala hereafter)

Regarding claim 30, Milsted teaches a system of Figs. 1a-d, the system (100) for distribution of licensed media assets, the system comprising:

a portal (103) (col 13/lines 24-25) to access licensed media assets (col 4/lines 26-32 and col 21/lines 32-38) by a plurality of media player devices (109) (col 9/lines 54-col 10/line 15 and col 14/line 51-col 15/line 9);

distributing license media assets in a variety of consumer services provided over the network that enforce the (usage) management rights provided by the portal, wherein each (user) consumer service is provided via subscription services model, thereby each consumer is associated with a subscription service to received (or by which the subscriber received) the services provided by the portal (col 15/lines 35-46, i.e. a user subscription);

license media asset is provided via said portal on an individual bases to end-user(s) (subscriber via subscription service) that has properly licensed associated media player devices(s) (i.e. specifying media player devices associated with subscriber subscription) (Milsted col 24/lines 50-62);

a master library of licensed media assets (101) accessible over the network (col 10/lines 16-35 and col 14/lines 5-50);

a virtual private library (i.e. license media assets from said master library) that is associated with the user subscription by which the user receives the services of the portal and includes one or more media assets in the master library that are licensed for use by the user associated with the user subscription (col 10/lines 16-37 and col 14/lines 5-20) for access by a plurality of media player devices (109) operated by the subscriber (col 9/lines 54-col 10/line 15, players col 14/lines 51-col 15/line 9);

the virtual media (i.e. license media assets from said master library) associated with the subscriber identifies or specifies ("references") the licensed media assets that are stored on a first media player device (col 89/lines 31-47, e.g. references to the usage of the licensed media assets stored on the media player devices);

the first media player device (109) including:

one or more media assets (content (113) accessed via associated license (660), col 30/lines 24-34) that are licensed for use by the (properly licensed) subscriber associated with the subscription via which services provided by the portal are received on the properly licensed media player devices(s) (col 24/lines 50-62, including multiple license devices col 89/lines 62-col 90/line 18, col 11/lines 61-col 12/line 7);

wherein any media player device(s) (109) may access one or more license media assets from said master library (col 14/lines 51-col 155/line 9);

the system being operable to provide media assets in the virtual private library by:

granting access multiple licensed media player devices (col 11/lines 61-col 12/lines 7, authorized release to properly licensed devices, col 24/lines 50-62, rights of the media player to the media asset are verified prior to release see col 44/lines 21-48);

whereby the user can access licensed media assets on the portal and the first media

player device (col 23/lines 41-61 and col 11/lines 61-col 12/line 7); however detect a user logging into the user account of the portal;

Inala teaches related to a portal system accessible over the Internet, discuss as prior art that a user is required log-in to subscription services provided by an Internet-Brokered service (i.e. portal) for every desired service access (col 1/lines 46-58), wherein logging (password based) subscriptions required user to access the account associated with the subscription (col 1/lines 57-col 2/line 6, col 5/lines 40-49), further teaching a password-all portal which provides log-in and sign-up services at said portal, wherein a user having a subscription sets-up an account, which will automatically and simultaneously provide access to the user to his account (col 6/lines 15-30).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Milsted for an open architecture to enable his teachings to be implemented in various technologies and transmission infrastructures and devices including Web and Internet technology. One ordinary skilled in the art would be motivated given the disadvantages noted by Inala pertaining the existing Internet portal systems to enhance the Milsted system enabling access to the portal by properly licensed plurality media player devices(s) owned by the subscriber to license other members under one subscription to user multiple devices, with the noted related disadvantages the Inala's teachings, such as different accounts associated with a single subscriber may be presented to the user in a hierarchical listing form to expedient user access.

Regarding claim 31, a ("media asset management") portal comprising features discussed on claim 30, same rationale of rejection is applicable; and application (195) enforces management rights in the media player devices (109) (col 14/lines 51-col 15/line 9, including multiple devices col 11/lines 61-col 12/line 7), management rights including enabling communication between two media players (col 23/lines 41-61, col 89/lines 62-col 90/line 18);

Regarding claim 32, wherein the virtual media asset library enables one of the media player devices to download the one media asset (Milsted; col 14/lines 62-col 15/line 9)

Regarding claim 33, wherein the virtual media asset library downloads or distributes (i.e. synchronizes) the one media asset with the at least two media player devices (Milsted: col 11/lines 61-col 12/line 7).

Regarding claim 34, a master media library database application (105) that manages access to a master library (101) of licensed media assets (Milsted: col 10/lines 16-35, col 14/lines 5-50), downloading one

media asset contained in the virtual media asset library (media assets from the master media library to which the user has license rights) with one of the media player device (Milsted: col 14/lines 62-col 15/line 9), including accessing and downloading media assets (Milsted: col 21/line 32-col 22/line 24).

Regarding claims 37-38, a user interface which enables the user to manage (request/download/display the virtual media asset library (Milsted: col 84/line 63-col 85/line 3, browser (191)/Web site see col 82/line 54-col 83/line 15).

Regarding claim 39, this claim comprises substantially the same features discussed on claim 30, same rationale of rejection is applicable.

Regarding claim 40, said synchronization is with respective media player devices' local database (196/197 of Fig. 1D).

Regarding claim 41, wherein the application supports an asset modification, asset addition feature (Milsted: col 54/lines 39-45)

Regarding claim 44, this claim is substantially the same as claims 30 and 37, same rationale of rejection is applicable.

Regarding claim 45, storing a plurality of licensed media assets associated with a subscriber having a subscription by which the services including said stored licensed media assets are provided by the portal (col 15/lines 35-46),

the subscriber properly license a plurality of media player devices for downloading from the portal (col 24/lines 50-62); reference is made prior to downloading to the validate the rights that the plurality of media player devices have, to the requested licensed media assets, thereby referencing stored identity to the plurality of media assets which the user has license to use (col 44/lines 21-48, referencing a database with all licensed identifiers see col 72/lines 38-49) to ensure that the subscriber only downloads the media assets to which he/she has rights to use;

user is able to manage (access) licensed media assets among the plurality of media player devices (col 14/lines 62-col 15/line 9 and col 89/lines 62-col 70/line 18).

Response to Arguments

6. Applicant argues (p. 7 remarks) regarding claim 1, rejected under Milsted in view of Novak, that because Milsted teachings pertain to anti-piracy and security the portal cannot be loaded with new “licensed” media assets. Furthermore, this capability cannot be achieved by combining the Milsted reference with the Novak reference.

In response to the above-mentioned argument, applicant’s interpretation of the prior art is noted, however, the Milsted reference may be combined with the Novak reference. In this case, Milsted discussed related to the distribution of digital assets, the issue of piracy by which media asset owners engage in unauthorized distribution and copying or pirating of digital media asset content (col 1/lines 55-col 2/line 55), however piracy is absolutely prevented with the teachings of Milsted, wherein software embedded in the content and executing at the media player disables the distribution to unlicensed device by unlicensed user(s) and the unauthorized copying of the licensed media asset (col 22/lines 42-col 23/line 2). Milsted’s piracy concerns are non-existent when his teachings are implemented, thereby it is not clear, how “the structure and mechanism presented in the Milsted reference would preclude” combining a reference which loads the portal with “new license media asset”, as argued.

Furthermore, Milsted concern with security are with respect to the transmission of the digital content over unsecured electronic networks (Internet & the Web) (col 3/lines 17-36), however Milsted integrates watermarking, compression/encoding, encryption technology to solve this (col 11/lines 10-26), further configuring the system of open architecture (col 11/lines 37-col 12/line 7) and network structure independent (col 15/lines 10-16). Thereby, it is not clear, how “the structure and mechanism presented in the Milsted reference would preclude” combining a reference which loads the portal with “new license media asset”, as argued.

7. Applicant’s arguments filed on filed 08/03/04 and/or 10/04/04 have been fully considered but not found persuasive.

8. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beatriz Prieto whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).



B. Prieto
Patent Examiner
December 4, 2004